

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

247171-000390USPT

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/797,839

Filed

March 10, 2004

First Named Inventor

John Blake

Art Unit

3653

Examiner

Gerald McClain

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/William D. PEGG, Reg. # 42,988/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

December 11, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐ \*Total of \_\_\_\_\_ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/797,839	Confirmation No.	5664
Applicants	:	John R. Blake <i>et al.</i>	Docket No.	247171-000390USPT
Filed	:	March 10, 2004		
TC/A.U.	:	3653	Examiner	: Gerald McClain
Title	:	Coin Processing Device Having A Moveable Coin Receptacle Station		

**PRE-APPEAL BRIEF RESPONSIVE TO FINAL OFFICE ACTION**

The Examiner set forth sixteen rejections (2-§112, 1<sup>st</sup> par., 2-§112, 2<sup>nd</sup> par., 1-§102, 11-§103). This pre-appeal brief will not attempt to address all of these rejections, but will merely present remarks to a representative sampling of the rejections, the §112 and §102 rejections, holding in abeyance treatment of the remainder of the §103 rejections until appeal should this pre-appeal panel deem the rejections appropriate to defend at the Board of Patent Appeals and Interferences.

**Claims 26-27 were finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

In determining whether a written description issue exists, the fundamental factual inquiry is whether the specification conveys *with reasonable clarity* to one of ordinary skill in the art that, as of the filing date sought, applicant was in possession of the invention claimed. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). It is the Examiner's burden to establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed (*see, e.g., MPEP* § 2163.01.III.A). The Examiner's vague assertion with respect to claim 26 that there may be other causes of the movement (of the platform) such as "tipping" the apparatus is inapposite and fails to show that the specification fails to convey, *with reasonable clarity* to one of ordinary skill in the art that, as of the filing date sought, applicant was in possession of a method comprising the acts of "opening a door of the housing prior to moving any coin receptacle platform" and "moving, only subsequent to the opening of the door of the housing, a coin receptacle platform from the first position." Accordingly, this rejection fails for at least the reason that the Examiner has failed to set forth a *prima facie* case.

Further, Appellants presented evidence supporting the sufficiency of the written description of claim 26. Following such evidence, the Examiner is required to "review the basis

for the rejection in view of the record as a whole, including amendments, arguments, and any evidence submitted by applicant” and “[i]f the record still does not demonstrate that the written description is adequate to support the claim(s), . . . fully respond to applicant’s rebuttal arguments, and properly treat any further showings submitted by applicant in the reply.” To this end, the Examiner asserts in his “Response to Arguments” that “Applicant has not refuted the possibility that there may be other causes of movement including tipping the apparatus.” The Examiner did not address the sufficiency of Appellants’ remarks or discuss the evidence presented thereby. The inquiry into whether the description requirement is met must be determined on a case-by-case basis and is a question of fact. *In re Wertheim*, 541 F.2d 257, 262 (CCPA 1976). The Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims. *In re Wertheim* at 263. The Examiner again commits legal error as the Examiner has not presented, by a preponderance of evidence, a basis for the written description rejection and has not explained how the Appellants’ evidence<sup>1</sup> was insufficient to overcome this rejection.

Moreover, on the merits, the “tipping” hypothetical presented by the Examiner does not discharge the legal burden incumbent upon the Examiner as it does not show why one skilled in the art would not recognize that the written description of the invention provides support for claim 26. With reference to FIG. 6, for example, Appellants submit that one of ordinary skill in the art would recognize in the specification that a door (e.g., 520) would need to be opened before the moveable platform 504a could be moved from the first position to permit access to the coin receptacle, as shown. The opening of the door is a prerequisite to movement of the moveable platform “to permit access to said coin receptacle” (see claim 26) and moving of the coin receptacle platform from the first position to permit access to the coin receptacle occurs only subsequent to the opening of the door of the housing. The Examiner’s “tipping” construct and associated rejection ignores the recitation of “sliding the moveable coin receptacle platform bearing said coin receptacle along the track from the first position to permit access to said coin receptacle,” and the disclosure of the specification as a whole (emphasis added)(e.g., with the door closed, even if the coin processing device is tipped, access is not granted to the coin receptacles). Claim construction is an essential part of the inquiry and analysis required of the

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<sup>1</sup> E.g., Par. [0051] discloses “[i]n operation, an operator of the coin processing device 500 that desires to access the coin receptacles first opens a front door 520 of the housing 503 to access the coin receptacles.” (see *also*, e.g., pars. [0038]; [0042]).

Examiner and each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. *See, e.g., In re Morris*, 127 F.3d 1048, 1053-54 (Fed. Cir. 1997). Every limitation must be considered. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995).

As to the Examiner's "finite movement" argument, the Appellant's Abstract states that "[e]ach moveable platform is moveable between a first position and a second position" wherein "[e]ach moveable platform is disposed entirely within the housing for receiving coins . . . when in the first position" and wherein "each moveable platform extends out of the housing when in the second position." (emphasis added). The Examiner's "finite movement" argument is completely contradicted by the claim language itself, which positively recites "each moveable platform extending out of the housing when in the second inoperable position" and by the specification, which clearly supports the claim. The Examiner has not shown the specification fails to convey, *with reasonable clarity* to one of ordinary skill in the art that, as of the filing date sought, applicant was in possession of a machine claimed. This rejection fails for want of a *prima facie* case of a lack of written description.

**Claims 26-27 were further finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite.**

Definiteness of claim language must be analyzed in light of the content of the application disclosure, the teachings of the prior art, and the claim interpretation that would be given by one of ordinary skill in the art at the time the invention was made. *See, e.g., In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971). The essential inquiry is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity. Claim 26 recites "opening a door of the housing". The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). Is the Examiner seriously contending that one of ordinary skill in the art, in view of the specification, would not know how to open the door of the housing? To the extent that the Examiner might be asserting that there are different types of doors and different manners of opening different doors, breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Claim 26 has not been shown to be indefinite. Likewise, claim 27 recites "a plurality of tracks, each of the plurality of individually moveable

platforms being connected to a respective one of the plurality of tracks and being physically constrained to slide only from said first operable position to said second inoperable position and from said second inoperable position to said first operable position along a corresponding one of said plurality of tracks" (emphasis added). The claim positively recites that the moveable platforms are "physically constrained to slide . . . along a corresponding one of said plurality of tracks". Claim 27 has not been shown to be indefinite.

**Claims 1-2, and 4 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hino *et al.* (US 2002/0162724) ("Hino"). Withdrawal of this rejection is requested.**

The Examiner continues to allege that Hino discloses a "dampening mechanism (See FIG. 4 below, C and 122a); coin receptacle station (120); first end (See FIG. 4 below, C); housing (110); second end (See FIG. 4 below, Back Side (opposite Front Side) of 122a)" (see Final Office Action, page 4). Thus, the asserted "dampening mechanism" is a front wall 122a of the drawer 122 (see par. [0136]). The front wall 122a serves to stop movement of the drawer 122 at a predefined point upon insertion of the drawer into the coin processing unit 110 housing.

In the Examiner's "Response to Arguments," the Examiner maintains that, regarding Hino, "[i]n the closing movement, C & 122a create a damping force at the *end* of the movement (Note: the *entire* movement was not claimed)" (Final Office Action, page 17)(emphasis in original). The Examiner states "[f]or the opening movement, either the . . . operator or some other structure that stops the movement generates damping force at the *end* of the movement". *Id.* It is noted that the Examiner's statement that "the *entire* movement was not claimed" evinces either a complete misreading of the claim or a disregard of the claim, as claim 1-2 and 4 clearly recite "a dampening mechanism configured to exert a damping force on the coin receptacle station *during movement of the coin receptacle from the first position to the second position and from the second position to the first position.*" (emphasis added). The damping mechanism produces a damping force on the coin receptacle station during movement of the coin receptacle from the first position (wherein the coin receptacle station is disposed entirely within the housing for receiving coins) to the second position (the coin receptacle station extending out of the housing) and back. This is not disclosed by Hino.

The Examiner further alleges that, for the opening movement, "the wheels 122b create friction, or a dampening force during the entire movement" and "the sides of the interior 110 and the outside rail of 122 are capable of producing friction, or dampening force". This argument

fails as well. Claims 1-2, and 4 recite “a *dampening mechanism* configured to exert a damping force on the coin receptacle station during movement of the coin receptacle from the first position to the second position and from the second position to the first position.” The claim language may not be construed in a manner inconsistent with the description of the invention in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-16 (Fed. Cir. 2005)(*en banc*). Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, *supra*. Claims terms may not be cavalierly disregarded. **The specification is the primary basis for construing the claims.** *Id.* at 1315. The Examiner’s strained hypotheticals are not legally controlling and are both factually and legally erroneous. The Examiner’s interpretation of claims 1-2 and 4 is at odds with the specification disclosure and is not reasonable, as adjudged by appropriate canons of claim construction and case law.

Further, claim 4 recites that “the dampening mechanism comprises a first end coupled to the housing and a second end coupled to the coin receptacle station.” **Hino fails to disclose “a dampening mechanism” comprising “a first end coupled to the housing and a second end coupled to the coin receptacle station.”** The Examiner’s citation of frictional force in wheel 122b or of possible interference between the outer surfaces of the coin processing unit 110 and the storage unit 120 fails to discharge the burden incumbent upon the Examiner to show that every element of the claimed invention is identically shown therein.

Again, this subset of rejections is believed to illustrate the quality and tenor of the final rejection, as a whole, and present a sufficient litmus test for the present pre-appeal panel as to the adequacy of these rejections, and the remaining rejections, in the Final Office Action.

Should any fees be required (except for payment of the issue fee) that have not otherwise been expressly authorized and/or paid, the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247171-000390USPT.

Respectfully submitted,

December 11, 2008  
Date

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